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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,273	03/27/2000	Steven B. Smith	9311.6	3734

21999 7590 03/30/2005

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EXAMINER

CHILCOT, RICHARD E

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/536,273

Applicant(s)

SMITH, STEVEN B.

Examiner

Richard E. Chilcot, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/27/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 25-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Pare, Jr. et al and Tracy et al. and the Stores publication by Gary Robins, entitled, "Portable POS", herein after Portable POS.

Fano teaches a PDA which is used in performing a wireless point-of-sale purchase transaction; the PDA comprises a microprocessor, a short range communication device which receives sales information from a wireless vendor device, a long range communication device which transmits purchasing information to a vendor including payment means (col. 47, line 58 through col. 52, line 15). While Fano teaches all the elements of the claimed invention, Fano fails to teach using the long-range communication for preauthorization of a purchase.

On the other hand, Pare, Jr. et al. teaches a tokenless, biometric transaction system which allows the purchaser to request authorization for a purchase. Pare, Jr. also teaches the authorization is transmitted to the vendor for the purchase of an item. It should also be noted Pare, Jr. et al. teaches a biometric input device.

Accordingly, to use the long range communication means of Fano to obtain a preauthorization for the purchase of an item, as suggested by Pare, Jr. et al., would have been obvious for one having ordinary skill in the art at the time of the invention.

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The advantage of such a modification to Fano would have been to provide greater security against fraud for the purchaser.

Fano fails to teach a vendor point of sale that includes a short-range communication device; however, Tracy et al. in col. 6, lines 26-51 teaches such a feature. Accordingly, to provide Fano with a vendor point of sale device as suggested by Tracy et al., would have been obvious for one having ordinary skill in the art at the time of the invention. The motivation for such a change would have been to promote sales for a vendor.

It is noted that all the references are silent regarding the preauthorization from a financial institution before the purchase of an item. However, the Portable POS publication teaches the value of the portable device is not limited to the space inside the four walls. Mervyns's has used the portable out of doors to open charge accounts before the store opens, while people are waiting outside the store before the "SUPER" events.

The customer answers some questions, a major credit card is swiped through the magnetic stripe reader, and the system goes out to the credit bureau for the approval process. The system prints out a temporary credit card slip with a temporary I.D. number and the person's name. The customer also gets a discount coupon.

Accordingly, to add the step of preauthorization to the system of Fano, as taught by Portable POS, would have been obvious for the skilled artisan. The motivation for this change would have increased the sales for a business as well as adding convenience for the customer.

Claims 25-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al. in view of Pare, Jr. et al. Treyz et al. teach all the features of the claimed invention with the exception of a tokenless, biometric transaction system which allows the purchaser to request authorization for a purchase. As note above Pare, Jr. et al. teach such a feature. Accordingly, Accordingly, to use the long range communication means of Treyz et al. to obtain a preauthorization for the purchase of an item, as suggested by Pare, Jr. et al., would have been obvious for one having ordinary skill in the art at the time of the invention. The advantage of such a modification to Treyz et al. would have been to provide greater security against fraud for the purchaser.

It is noted that Treyz et al. is silent regarding the preauthorization from a financial institution before the purchase of an item. However, the Portable POS publication teaches the value of the portable device is not limited to the space inside the four walls. Mervyn's has used the portable out of doors to open charge accounts before the store opens, while people are waiting outside the store before the "SUPER" events.

The customer answers some questions, a major credit card is swiped through the magnetic stripe reader, and the system goes out to the credit bureau for the approval process. The system prints out a temporary credit card slip with a temporary I.D. number and the person's name. The customer also gets a discount coupon. Accordingly, to add the step of preauthorization to the system of Treyz et al., as taught by Portable POS, would have been obvious for the skilled artisan. The motivation for

this change would have increase the sales for a business as well as adding convenience for the customer.

Response to Arguments

Applicant's arguments filed December 27, 2004, have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to applicants' arguments that Fano and Treyz references do not teach "automatically receiving product offers", the examiner is of another opinion. In particular, Treyz teaches the wireless device allows the user to be alerted when a message is received from a nearby merchant. The user may also be alerted to the availability of a special. Messages regarding specials may include interactive features. Also, Fano teaches an agent running on a Personal Digital Assistant (PDA) equipped with a Global Positions System (GPS) receiver, supports location targeted shopping in an outdoor mall. The agent assists shoppers by providing information about merchandise in which the shopper has expressed an interest. As a shopper strolls through a mall, the system alerts the shopper to merchandise of previously specified categories in the surrounding stores, as well as any cheaper alternatives in the local area.

With respect to applicants' argument that the prior art fails to teach receiving credit authorization, the examiner respectfully disagrees. Pare, Jr. clearly teaches such a feature.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

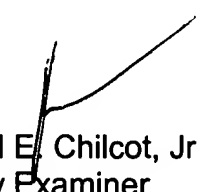
This is a RCE of applicant's earlier Application No. 09/536,273. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard E. Chilcot, Jr. whose telephone number is 703-305-4716. The examiner can normally be reached on 5/4/9 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard E. Chilcot, Jr.
Primary Examiner
Art Unit 3627